



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,130	12/20/2001	Christine J. Landry-Coltrain	82966LMB	2370

7590

02/11/2005

Paul A. Leipold
Patent Legal Staff, Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER

SCHWARTZ, PAMELA R

ART UNIT PAPER NUMBER

1774

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,130

Applicant(s)

LANDRY-COLTRAIN ET AL.

Examiner

Pamela R. Schwartz

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 1-20, 47 and 52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-46, 48-51, 53 and 54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-54 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1774

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-46, 48-51, 53 and 54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment to the independent claims is confusing. Applicants state that support for this amendment is found in Table 4 on page 23 of the specification. The examiner has focused on PE-4 which appears to be the source of applicants' intended support for the amendment. As currently presented, the claims appear to be broader than the supporting description in the disclosure and to contain new matter. First, in order to be consistent with the scope of the example relied upon, the claim should recite that all of the polyester particles are cross-linked, not just the percentage that has a mean diameter of less than 0.5 micrometers. Second, it is unclear where applicants find support for the language "by weight" in these claims. Therefore, this language is considered to be new matter. Applicants are invited to overcome this rejection by showing where it is supported in the specification.

2. Claims 21-46, 48-51, 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al. (Japanese Kokai Patent Application No. Hei 7[1995]-137432) for reasons of record and for reasons given below. With respect to the new

Art Unit: 1774

claim limitations, it is noted that the particles of Maeda et al. are cross-linked [0008].

With respect to the limitation of the percentage of particles with a mean particle size below 0.5 microns, Maeda et al. uses different terminology to recite particle size, but it appears that its ranges would overlap with those instantly claimed. Maeda et al. disclose a volume average particle size D that can be 0.5 microns. In addition, 70 wt % or more of the particles are in the size range of $0.5D$ - $2.0D$ (i.e: 0.25 microns to 1 micron). Applicants claim 21 requires that at least 58% by weight of the particles have a mean diameter of less than 0.5 micrometers. Since almost half of the 58% as well as the other 42% of the particles can have particle sizes over 0.5 microns, the claim reads on Maeda et al. Such particle size distributions would clearly have been suggested by [0006] of Maeda et al. In addition, claim 29 states that the particles of claim 21 are "a component of an at least bimodal system" including other (larger) particles. If this is the case then the percentage set forth in claim 21 is essentially non-limiting. Claim 21 would not appear to recite the complete set of component particles which may be present.

The amendment to claim 29 does not overcome the applicability of the Maeda et al. reference. As it is written, the claim is broad enough for multiple "at least bimodal" systems to be present. Such multiple systems could cancel out the modality of the other systems that are present. Assuming that the porous particles of Maeda et al. are mono-modal when taken as a whole, when subdivided into such systems, one system would be present which was at least bimodal and would have a mean particle diameter of greater than 0.5 micrometers.

Art Unit: 1774

3. Rejection over Okumura et al. (5,360,780) is withdrawn because the reference does not teach or suggest inclusion of polyester particles that have been cross-linked. In addition, the obvious type double patenting has been overcome by the filing of terminal disclaimers.

4. Applicant's arguments filed November 26, 2004 have been fully considered but they are not persuasive. As stated above, applicants do not require 58% of the particles to have diameters of less than 0.5 microns. The particles of Maeda et al. may have an average particle size of 0.5 microns and from consideration of [0006] of the reference, one of ordinary skill in the art would have found it obvious to form the medium of Maeda et al. with about 50% of the particles having a particle size of less than 0.5 microns to achieve an average particle size of 0.5 microns.

Gloss is not recited by the instant claims and it is unnecessary for Maeda et al. to recite this property for the claims to read on the reference. It is also well known in the art that smaller particles in a layer increase gloss. Consequently, one of ordinary skill in the art would have found it obvious to use particle sizes at the lower end of the range of Maeda et al. in order to result in a layer of higher gloss. See for example Ogawa et al. (5,576,088), col. 5, lines 13-15. Results of increased gloss would not have been unexpected when smaller particles are included in the medium. While Maeda et al. may recognize certain drawbacks to the inclusion of small particles, one of ordinary skill in this art would have found it obvious to weigh all of the pros and cons of this aspect of the invention to determine appropriate sized particles for inclusion in the layer.

Contrary to Table B and the arguments made pertaining thereto, the instant claims do not require that 58 weight % of the particles have diameters of less than 0.5 microns.

With respect to claim 29, it is the breadth of the claim that allows the claim to read on the reference. Therefore Mr. Leon's declaration is not persuasive in overcoming rejection of this claim. As written, the claim is not limited to particles of bimodal distribution, and indicates that other particles would be present as well.

With respect to the claims directed to acid numbers, Mr. Leon's first declaration indicates that this is a measure of the extent of polymerization, as well as other potential side reactions. His declaration appears to indicate that this value cannot be determined for the Maeda et al. particles without preparing the particles of Maeda et al. It would have been obvious to one of ordinary skill in the art to monitor and determine the appropriate degree of progress of the formation reaction of Maeda et al. in order to result in desired cross-linked particles for inclusion in the medium of Maeda et al.

With respect to claims reciting more than one layer, since the claims use "open" claim language, layers recited as including particles with a mean diameter of greater than 0.5 microns are not precluded from including other particles as well. Therefore, the compositions of these layers can be the same. With respect to Maeda et al., the examiner intended to indicate that there is no difference between one layer or two layers if the compositions and thicknesses are the same, particularly because it is well known to coat multiple times in order to increase coating thickness.

The Second Declaration of Ms. Landry-Coltrain is not persuasive for reasons set forth above. One of ordinary skill in the art would have found it obvious to include smaller particles in order to increase gloss. This is well known in the art.

The Second Declaration of Mr. Leon has also been considered, but does not overcome rejection based upon Maeda et al. for the reasons set forth above. The examiner is unsure how the declaration is relied upon to overcome the rejection of record but will be glad to give reconsideration to the declaration if applicants explain how the declaration distinguishes the claims from Maeda et al.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Art Unit: 1774

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz
February 9, 2005



PAMELA SCHWARTZ
PRIVATE EXAMINER